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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/310,294	05/12/1999	YONAH SCHMEIDLER	111283.137US2	8643
23483	7590	09/22/2004	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP			ARANI, TAGHI T	
60 STATE STREET			ART UNIT	PAPER NUMBER
BOSTON, MA 02109			2131	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/310,294

Applicant(s)

SCHMEIDLER ET AL.

Examiner

Taghi T. Arani, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 0204.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-20 and 33-39 is/are allowed.
- 6) ☒ Claim(s) 1-10, 21-31 and 40-42 is/are rejected.
- 7) ☒ Claim(s) 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

### DETAILED ACTION

Claims 1-42 were pending for examination

Claims 1-10, 21-31, 40-42 are rejected.

Claim 32 is objected.

Claims 11-20 and 33-39 are allowed.

Previous Non-Final office action was not complete due to not-examined claims 21-42 submitted in a preliminary amendment . Therefore the examiner is providing the following complete Non-Final action which includes claims 1-42.

#### *Claim Rejections - 35 USC § 103*

**Claims 1-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Auerbach et al., U.S. Pat. No. 5,673,316 issued Sep. 30, 1997 and further in view of Downs et al, US Pat. No. 6,226,618 filed on August 1998 (issued May 2001).

**As per claim 1**, Auerbach is directed to a method and apparatus to create, distribute, sell and control access to digital contents using secure cryptographic envelope, see abstract.

Auerbach discloses steps of a cryptographic envelope process where the main entities involved in the process are the Document Server (i.e. a content server), the Buy Server (i.e. an access server), the description fingerprinting and watermarking module (DFWM), and user personal computer (UPC), see col. 2, lines 42-49.

Auerbach 's creation of a cryptographic envelope of digital content is done off-line by the document provider (i.e. a content server) and can be distributed or stored on any servers without any security requirement on the server, col.3, lines 44-48, see also col. 6, lines 40-42.

Auerbach's cryptographic envelope is a grouping of information parts. Information parts are of two types: document and control parts. Document parts are the "contents" and control parts the metadata needed to support the functions such as authentication and confidentiality of a cryptographic envelope, col. 4, lines 3-5 and lines 25-35, see also Fig. 2, reference numbers 201-211 for elements of a cryptographic envelope.

Once information parts to be included in the cryptographic envelope are assembled, each document part is encrypted with its part encryption key (PEK) to form encrypted part, which is included in the cryptographic envelope, col. 5, lines 57-67.

Then the PEKs are encrypted using public key a Buy Server (i.e. an access server) and are included in the cryptographic envelope, see col. 6, lines 1-5. Other elements such as abstracts, table of content, terms and conditions and a list of information parts are also included in cryptographic envelope. That is, the cryptographic envelope is self-contained and unexecutable and can be used as a basis for designing and implementing distributed access control of digital documents, see col. 2, lines 3-10.

Auerbach further teaches that the digital contents through cryptographic envelopes are distributed by any means including over the Internet, see col. 6, lines 30-42. That is, The Document Server (DS), the Buy Server (BS) and the client process (UPC) are coupled to a network.

Auerbach further teaches that a user (i.e. a client coupled to the network) interested in the cryptographic envelope content, browses the plain text portion of the envelope (i.e. a "teaser") and would have to buy (or obtain) the necessary PEKs (i.e. content encryption keys necessary to obtain the digital content(s)) from the buy server

(i.e. an access server) prior to obtaining the digital content from the content server, col. 6, lines 43-48, see also Fig 1.

Auerbach does not explicitly teach obtaining the location identifier of the title from the buy server.

However, Downs discloses a Secure Digital content Electronic Distribution which includes Content Provider, Electronic Digital Content Store, Intermediate Market partners, Clearinghouse, Content Hosting Site, Transaction Infrastructure, and End-User Device, col. 8, lines 54-67. Secure Digital content Electronic Distribution enables the secure delivery of high-quality, electronic copies of content to End-User Device and to regulate and track usage of the content, see col. 12, lines 7-11.

Downs further teaches that licensing authorization and control are implemented through the use of a Clearinghouse(s) entity and Secure Container (SC) technology. The Clearinghouse(s) provides licensing authorization by enabling intermediate or End-User(s) to unlock content after verification of a successful completion of a licensing transaction. Secure Containers (SC) are used to distribute encrypted content and information among the system components, col. 7, lines 12-18.

Downs further discloses metadata secure containers that are built by content provider and includes an external URL (Uniform Resource Locators or location identifier) to point to the content, 26, lines 41-42

It would have been obvious to one of ordinary skill in the art to modify the digital container of Auerbach to that of Downs to include a URL (i.e. a location identifier) because the size of the content is typically too large to efficiently download the

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containers just for the purpose of accessing the descriptive metadata. Instead, the external URL (Uniform Resource Locators) to point to the content, col. 26, lines 35-40.

**As per claims 2**, Auerbach teaches this. Through the Graphical User Interface, the user is prompted with a list of articles (i.e. contents) contained in the cryptographic envelope. After browsing the relevant articles, the user would initiate a buy request message (BRM) and would send it to the Buy Server (i.e. access server), col. 8, lines 7-14.

The Buy Server then prepares a buy server response (BSR) in the form of a "License Cryptographic Envelope" or "key" to unlock the cryptographic envelope and sends it back to the user. Auerbach further teaches that standard cryptographic techniques such as encryption and authentication can be applied to protect the privacy and authenticity of a BSR. col. 10, lines 35-50. That is the user would be required to obtain a signature of the buy server to open the cryptographic envelope provided by the content server.

**As per claim 3**, Auerbach teaches that the information parts of the cryptographic envelope are of two types: document and control. The control parts are the meta-data needed to support and process the cryptographic envelope. Examples of the control parts are price matrix describing the pricing structure of the purchase of the content such as volume discount, discount for club membership. Auerbach further teaches that the price discount may be time dependent. That is, the terms and conditions on the purchase and use of the digital content are also included in the cryptographic envelope and is evaluated by the buy server, see col. 4, lines 9-64.

Referring to claims 4 and 5, Downs's secure content (SC) includes at least one bill of material part which includes information such as SC version, expiration date of SC, ID, etc., see col. 25, lines 7-35. Down further implements "Rights Management" functions into secure container which includes licensing authorization enforcing usage conditions of purchase or license, such as permitted number of copies, number of plays, and the time interval or the term license may be valid, see column 6, lines 65-67 though col. 7, lines 1-19.

The examiner asserts that obtaining a new time data from the content provider or retailers would be an obvious variation of the cryptographic envelope (or secure container) of Auerbach to extend or renew the license terms under control of the access server (or clearinghouse) after the secure container's time period expires.

Apparatus claims 6-9 corresponds to method claims 1-5 and are rejected for the same reasons provided in the rejection of claims 1-5.

Referring to claims 10, Auerbach discloses that once a cryptographic envelope is created, it can be distributed by any means, e.g. sending over Internet, by radio, or television signals, by cable, by satellite, by CD-ROM, and by BBS, col. 1, lines 54-65, see also Downs, col. 11, lines 55-61.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 21-31 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 5-12 of prior U.S. Patent No. 6763370. This is a double patenting rejection.

**As per claim 21** of the instant application, claim 5 of '370 recites:

An access server connectable to one or more requestor processes and one or more content servers over a computer network, each content sever including server memory storing one or more content titles in an unexecutable form, the access server comprising: conversion logic configured to convert a title identifier received from a requestor process into a location identifier, the title identifier corresponding to a title selected by the requestor process, the location identifier indicating an address on the network for the content server storing the selected title; activator generator logic configured to generate an activator usable by the requestor process, the activator containing data necessary to process the requested title stored on the content server into executable form; and token generating logic configured to generate a token containing data identifying the title requested by the requester process and data specifying a time period for accessing the requested title from the content server.

**As per claims 22-23**, Claim 10 of the patent '370 recites:

[ the] program logic [of the content server] responsive to a token received from the client system containing data identifying a content title stored on the content server, the program logic configured to authenticate the title identification data and, after



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authentication, enabling access to at least a portion of the title identified by the token (i.e. content server authenticates the content title identification data on the token prior to enabling access to the content, recited in claim 23).

**As per claim 24**, claim 11 of the patent '370 recites:

[w]herein the token specifies a time period for providing access to the title identified by the token, the program logic of the content server being configured to enable access to at least a portion of the identified title only during the time period specified by the token.

**As per claim 25**, claim 11 of the patent '370 recites:

[w]herein the token further contains data specifying a start time and an end defining the specified time period.

**As per claims 26**, claim 5 of the patent '370 recites:

[wherein, the access server further comprises] token generating logic configured to generate a token containing data identifying the title requested by the requester process and data specifying a time period for accessing the requested title from the content server.

**As per claim 27**, claim 11 of the patent '370 recites:

[w]herein the token further contains data specifying a start time and an end defining the specified time period.

**As per claim 28**, Claim 6 of the patent '370 recites:

[W]herein, the token generating logic provides the token with data identifying the access server.

**As per claim 29**, claim 5 of the patent '370 recites:

[T]he access server comprising: conversion logic configured to convert a title identifier received from a requestor process into a location identifier, the title identifier

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corresponding to a title selected by the requestor process, the location identifier indicating an address on the network for the content server storing the selected title.

**As per claim 30**, claim 5 of the patent '370 recites:

the access server comprising: .....activator generator logic configured to generate an activator usable by the requestor process, the activator containing data necessary to process the requested title stored on the content server into executable form.

**As per claim 31**, claim 8 of the patent '370 recites:

[W]herein the data necessary to process the requested title stored on the content server into executable form includes cryptographic data.

#### ***Allowable Subject Matter***

Claim 32 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### **Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taghi T. Arani whose telephone number is (703)305-4274. The examiner can normally be reached on 8:00-5:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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